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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,742	09/03/2004	Sachio Nagamitsu	MTS-3456US	5279

23122 7590 03/17/2008

RATNERPRESTIA
P O BOX 980
VALLEY FORGE, PA 19482-0980

EXAMINER	
BORISSOV, IGOR N	
ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
03/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/506,742	NAGAMITSU ET AL.	
	Examiner	Art Unit	
	Igor N. Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Preliminary Amendment received on 09/03/2004 is acknowledged and entered. Claims 1-21 have been canceled. New claims 22-52 have been added. Claims 22-52 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 includes a following limitation:

"an LCA data storage means of storing an environmental burden generated at whole *or* part of the *steps of producing, operating and discarding the energy generating means* as a first life cycle assessment (LCA) data and an environmental burden generated at whole *or* part of the steps of producing, operating and discarding facilities of supplying the external energy as a second LCA data ";

"an interface means of presenting the energy generation cost, the external energy supply cost, and the first and the second LCA data and allowing the user to perform setting the energy generating means *and/or* the supply of the external energy.

First, the use of alternative language make the claim confusing. Furthermore, the language of the claim is vague and indefinite, because it is not clear which parts of the claim recite a new structural elements and which indicate the method steps (steps of producing, operating and discarding) or intended use of the system. Same reasoning applied to the remaining claims.

Claims 23 and 50 refers to "remaining data", which is confusing. It is not clear what data is considered.

Claims 49-52 are confusing because it is not clear to what extend a structural element (means plus function) represents a code per se (a program).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 49-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.

The claim, as currently recited, appears to be directed to a program which is nothing more than software or computer-executable instructions, or code per se. Therefore, the claim is considered to be directed to a non-statutory class of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arita et al. (US 2004/0199478 A1) in view of Sakurai et al. (us 2002/0035550 A1).

Claims 22-24, 46-51,

Arita et al. teaches a method, system and a computer-readable medium having a computer-readable instructions embedded therein for causing a computer to implement said method for supplying a generated energy into a load, comprising:

an energy generation cost calculating means of calculating energy generation cost required to generate the generated energy by the energy generating means suitable for the load; an external energy supply cost calculating means of calculating supply cost of the external energy suitable for the load; an LCA data storage means of storing an environmental burden generated at whole or part of the steps of producing, operating and discarding the energy generating means, and an interface means of presenting the energy generation cost, the external energy supply cost, and the first and the second LCA data and allowing the user to perform setting the energy generating means and/or the supply of the external energy (Fig. 5; 0042; 0047; 0050; 0052; 0067; 0083).

Arita et al. does not specifically teach that manipulated data includes information regarding life cycle assessment (LCA) data.

Sakurai et al. teaches a method and system for providing environmental management information, wherein total cost of a life cycle assessment data for a product is assessed considering environmental impacts at the time of supplying materials or parts and at the time of fabricating products (0005; 0188; 0189).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Arita et al. to include that that manipulated data includes information regarding life cycle assessment data, as disclosed in Sakurai et al. because it would advantageously allow to minimize the environmental impacts with high efficiency, as specifically stated in Sakurai et al. (0005). Furthermore, in this case, each

of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida,* 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 25-35, 37-39, and 42-45, see reasoning applied to the independent claims.

Claim 36. Arita et al. teaches providing optimization and re-optimization means for deciding the most suitable electric power purchasing pattern based on various criteria (Figs. 5, 14; 0083), thereby suggesting said feature.

Claim 40, to store data in a form of a table is old and well known. The motivation would be to decrease computation time and, therefore, ability to employ a less powerful processor.

Claim 41, to use a fuel cell as energy generating means is old and well known. The motivation would be to provide a back-up energy source.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

03/01/2008